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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,685	04/27/2001	Shuhei Yamamoto	N9450.0013/P013	9040
24998	7590	05/18/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L Street, NW Washington, DC 20037			CHOI, LING SIU	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 05/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/842,685

Applicant(s)

YAMAMOTO ET AL.

Examiner

Ling-Siu Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-27 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 13-15 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 10-12, 16-18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to the Amendment filed February 7, 2005. Claims 1-3 were canceled and claims 4-27 have been added. Claims 4-27 are now pending, wherein claims 4-6, 10-12, 16-18, and 22-27 are drawn to a capillary array electrophoresis apparatus; claims 7-9, 13-15, and 19-21 are drawn to a set of adapters. Since claims 7-9, 13-15, and 19-21 are patentably different from claims 4-6, 10-12, 16-18, and 22-27 and are presented after non-final Office Action, these claims will not be considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

3. Claims 4-6, 10-12, 16-18, and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, lines 9-10, the recitation "a plurality of kinds of sample plate having **different shape**, size and/or **well depth**" causes indefiniteness because there is no support in the specification to cite such limitation.

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**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4-6, 10-12, 16-18, and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Moring et al. (US 5,384,024).

<b>A capillary array electrophoresis apparatus comprising</b>	
a capillary array (a plurality of capillaries)	the capillaries having <i>sample injection top ends</i> that are arranged in alignment
a sample plate assembly	a sample plate having a plurality of wells for holding a sample and an adapter for mounting the sample plate
an auto sampler	holding the sample plate assembly and being movable at least in a vertical direction and permits the <i>sample injection top ends</i> of the capillary array to immerse into the sample in the plurality of wells
wherein the adapter is prepared for a <b>plurality of kinds of sample plate</b> having different shape, size and/or well depth so that center axes and bottom heights of the wells of the sample plate are adjusted to assume a predetermined position with respect to the auto sample	

(summary of claim 4)

The rejection is adequately set forth in paragraph 4 of the previous Office Action and is incorporated herein by reference.

***Response to the Applicants' Arguments***

6. Applicants' arguments filed February 7, 2005 have been fully considered but they are not deemed to be persuasive.

Applicants: "Moring discloses an auto sampler, for a capillary array electrophoresis apparatus,..... However, different from the claimed invention, ....Moring apparatus can not make use of a sample plate or a micro tighter plate provided with a plurality of wells. Moreover,...Moring apparatus cannot be adapted for a sample vial having a different size."

Moring et al. disclose an **capillary electrophoresis** comprising a rotary carousel having multiple circular locations for liquid containers, wherein the **carousel is translatable** as well rotatable and wherein a removable tray facilitate loading and unloading groups of sample containers and buffers container to the instrument (col. 2, lines 67-68; col. 3, lines 1-4, 9-13, and 39-41; claim 1). With referring to the different size, there is no support for applicants to make such limitation.

***Conclusion***

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.

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*Ling Sui Choi*

**LING-SUI CHOI**  
**PRIMARY EXAMINER**

May 15, 2005